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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,485	09/24/2001	Noriyuki Suzuki	010507	5936

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EXAMINER

RONESI, VICKY M

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/806,485

Applicant(s)

SUZUKI ET AL.

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/28/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Claim Objections*

2. Claim 1 is objected to because on line 17 “and” should be replaced with “or.” As currently written, the conjunctive word “and” suggests both (a) and (b) yet in the preceding line the phrase “at least one of” is recited which necessitates the use of alternative language, “or.”

Claims 7 and 8 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations “[N] value is 30 or more” (claim 7) and “average aspect ratio is 10 to 300” (claim 8) are recited in lines 20 and 24 of independent claim 1 and are not mandatorily present (note line 16 of claim 1, “at least one of...”).

Claim 10 is objected to because of a typographical error. On line 15, the word “the” should be deleted so that the claim reads as “(A) is three...”

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Two obviousness-type double patenting rejections are set forth below.

*Double Patenting, I*

3. Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8 and 9 of U.S. Patent No. 6,239,195. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

US '195 discloses a thermoplastic composition comprising a generic thermoplastic resin, a silane-treated foliated phyllosilicate that is prepared by introducing an organosilane compound identical in chemical structure to that presently claimed where the average and maximum layer thickness ranges significantly overlap the presently claimed ranges and a method of making that reads on the method presently claimed in claim 9. Since the thermoplastic resin of US '195 is generic in scope with respect to polyester, polycarbonate, and polyarylate resins as presently claimed, the scope of the presently cited claims is therefore fully encompassed by claims 8 and 9 of US '195. It is noted that the presently claimed conditions (i), (ii), and (iii) are applicable only to a thermoplastic polyester resin and are therefore not relevant towards a generic thermoplastic resin as disclosed by US '195.

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4. Claims 1-9 are directed to an invention not patentably distinct from claims 8 and 9 of commonly assigned U.S. Patent No. 6,239,195 B1. Specifically, see the rejection set forth in paragraph 3 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned U.S. Patent No. 6,239,195 B1, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

5. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,239,195 B1. See the rejection set forth in paragraph 3 above.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of

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invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(1)(1) and § 706.02(1)(2).

#### *Double Patenting, II*

6. Claims 1 and 4-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,583,208 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

US '208 discloses a resin composition comprising a thermoplastic polyester resin and a silane-treated foliated phyllosilicate that is prepared by introducing an organosilane compound identical in chemical structure to that presently claimed where the average and maximum layer thickness ranges significantly overlap the presently claimed ranges. It is the examiner's position that the presently claimed properties (i), (ii), and (iii) are intrinsic in US '208 since its composition meets the presently claimed composition limitations, thereby rendering the presently cited claims obvious over US '208.

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7. Claims 1 and 4-8 are directed to an invention not patentably distinct from claims 1-4 of commonly assigned U.S. Patent No. 6,583,208 B1. Specifically, see the rejection set forth in paragraph 6 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned U.S. Patent No. 6,583,208 B1, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al (WO 97/43343).

It is noted that the international Patent Application WO publication is being utilized for date purposes. However, since WO 97/43343 is in Japanese, in the discussion below, the US equivalent for WO 97/43343, namely US 6,239,195, is referred to in the body of the rejection below. All column and line citations are to the US equivalent.

Suzuki et al discloses a thermoplastic resin composition for injection molding (col. 20, line 49) comprising a thermoplastic resin such as polyester resins, polycarbonate resins, and polyarylate resins (col. 4, lines 40-41) and a silane-treated foliated phyllosilicate that is prepared by introducing an organosilane compound identical in chemical structure to that presently claimed with a range of layer thickness values that substantially overlaps the presently claimed values (claims 1, 8, and 9 of Suzuki et al). A method of making said composition is also disclosed which includes expanding the basal spacing of a swellable layered silicate to three time or more larger than the initial basal spacing of the swellable silicate (col. 10, lines 23-25) in a dispersion medium by introducing the organosilane compound and mixing the dispersion with monomer of the thermoplastic resin (i.e., polymerizable prepolymer) and then polymerizing the polymer (col. 34, lines 11-64). It is noted that the limitations "[N] value is 30 or more" (present claims 1 and 7) and "average aspect ratio is 10 to 300" (present claims 1 and 8) are not mandatorily present (note line 16 of present claim 1, "at least one of...").

With respect to a resin composition with a thermoplastic polyester resin, Suzuki et al discloses that the clay dispersion medium comprises water or a polar solvent soluble with water (col. 9, line 49-50). Although Suzuki et al does not disclose the viscosity properties as presently claimed in claim 1, parts (i), (ii), and (iii), it is the examiner's position that such properties are



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inherent in Suzuki et al since it meets the composition limitations. Further evidence to support the examiner's position is found in the present specification which discloses on page 59, lines 6-14 that the logarithmic viscosity of the resulting polyester resin is preferably from 0.40 to 1.8 dl/g (see present Table 4-2 on page 125 for exemplified values of 0.54 to 0.61 dl/g), a range that overlaps the logarithmic viscosities disclosed in Suzuki et al's PET examples (examples 1-3, 5, 7-9), 0.59-0.65 dl/g. Moreover, case law holds that "the fact that a characteristic is a necessary feature or result of a prior-art embodiment (that is itself sufficiently described and enabled) is enough for inherent anticipation, even if that fact was unknown at the time of the prior invention." See *Toro Co. v. Deere & Co.*, 355 F.3d 1313, 1320, 69 USPQ2d 1584, 1590 (Fed. Cir. 2004).

In light of the above, it is clear that Suzuki anticipates the presently cited claims.

### *Correspondence*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vickey Ronesi  
September 21, 2004



  
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